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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/870,147 | 05/30/2001 | Toshiaki Tsuboi | 10746/26 | 8853 |
| 26646 | 7590 | 09/12/2005 | EXAMINER | |
| KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004 | | | PASS, NATALIE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3626 | |

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/870,147 | Applicant(s) TSUBOI ET AL. | |
| | Examiner Natalie A. Pass | Art Unit 3626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 30 May 2001. Claims 1-17 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claim 17 only recites abstract ideas. The recited claim detailing the steps of obtaining data, obtaining a scenario, preparing a schedule, and outputting information does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute different parts of a method for supporting health promotion.

Furthermore, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, as recited in claim 17, the claimed invention produces a health promotion schedule (i.e., repeatable) that can be used in promoting a healthy lifestyle to a client (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 17 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 7, 9-10, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580.

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(A) As per claim 17, Strecher teaches a method of supporting health promotion for preventing diseases caused by lifestyles and for promoting and maintaining health by using a health promotion practitioner support apparatus, said method comprising the steps of:

obtaining data on lifestyles (Strecher; column 2, lines 12-30) and “motives cited by the user” (reads on “a level of readiness for change of a client”) (Strecher; column 4, lines 22-26);

obtaining a scenario which includes health promotion information and health promotion timing for each of levels of readiness for change (Strecher; column 2, line 53 to column 3, line 5, column 4, lines 5-31); Examiner interprets Strecher’s teachings of collecting data “about the pattern and history of the health-related behavior” as a “scenario.”

preparing a health promotion schedule of said client from said scenario and said data, and outputting said health promotion schedule (Strecher; column 3, lines 5-12, column 3, line 61 to column 4, line 3); and

outputting “feedback” (reads on “health promotion information for said client according to operation to said health promotion schedule”) (Strecher; column 3, lines 5-12, column 3, line 61 to column 4, line 3).

Although Strecher does not explicitly teach “a scenario” it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize or “incorporate” such information “into the algorithm” with the motivations of “initiat[ing] the health-related behavior change process” and “to create tailored advice” using data collected about the pattern and history of the health-related behavior (Strecher; column 4, lines 5-27).

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(B) Apparatus claim 1 repeats the subject matter of claim 17, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 17 have been shown to be obvious in view of the teachings of Strecher in the above rejections of claim 17, it is readily apparent that the system disclosed by Strecher includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 17, and incorporated herein.

(C) Claim 9 differs from method claim 17 by reciting a “computer readable medium storing program code...” in the preamble and “program code” recited in a “means plus function” format in the limitations. As per these limitations, Strecher clearly discloses his invention to be implemented on a computer readable medium storing program code (Strecher; column 4, lines 58-60, column 5, lines 24-29). Furthermore, as the method of step claim 17 has been shown to be disclosed or obvious by Strecher, it is readily apparent that the “means” to accomplish those method steps is obvious in view of the prior art. As such, the limitations recited in claim 9 are rejected for the same reasons given for method claim 17 and incorporated herein

(D) As per claims 2, 10, Strecher teaches an apparatus as analyzed and discussed in claims 1 and 9 above,

said part and said program code means for obtaining data comprising: a part and program code means for outputting information used for interviewing said client (Strecher; column 2, lines 39-57); and

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a part and program code means for receiving responses of said client (Strecher; column 2, lines 24-29).

(E) As per claims 7, 15, Strecher teaches an apparatus and medium as analyzed and discussed in claim 1 above

further comprising: a part storing plurality of kinds of health promotion information, said plurality of kinds of health promotion information including interview health promotion information, telephone health promotion information, and documents to be “provided to the user” (reads on “sent physically or by electronic mail”) (Strecher; column 2, lines 13-24, 60-62, column 4, lines 5-26, 34-48);

and wherein said part outputting health promotion information outputs said health promotion information by means suitable for one of said kinds of health promotion information (Strecher; column 2, lines 13-24, 60-62, column 4, lines 5-26, 34-48, column 5, lines 27-38).

6. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 as applied to claims 2 and 10 above, and further in view of Rieger et al. article: “Development of an Instrument To Assess Readiness to Recover in Anorexia Nervosa.” 2000. URL: <<http://www3.interscience.wiley.com/cgi-bin/fulltext/74000261/PDFSTART>>, hereinafter known as Rieger.

(A) As per claims 3, 11 Strecher teaches an apparatus and medium as analyzed and discussed in claims 2 and 10 above.

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Strecher fails to explicitly disclose

said part outputting information used for interviewing said client comprising:

a part outputting question information for checking said level of readiness for change;

and

a part determining said level of readiness for change according to a response to said question information and determining information to be output hereafter according to said level of readiness for change; wherein said health promotion practitioner support apparatus determines said health promotion information according to responses of said client.

However, the above features are well-known in the art, as evidenced by Rieger.

In particular, Rieger teaches

said part outputting information used for interviewing said client comprising:

a part outputting question information for checking said level of readiness for change

(Rieger; Abstract, page 389, last paragraph to page 391, first paragraph); and

a part determining said level of readiness for change according to a response to said question information and determining information to be output hereafter according to said level of readiness for change (Rieger; Abstract, page 389, last paragraph to page 391, first paragraph); wherein said health promotion practitioner support apparatus determines said health promotion information according to responses of said client (Rieger; Abstract, page 389, last paragraph to page 391, first paragraph).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus and medium of Strecher to include these limitations, as taught

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by Rieger, with the motivations of increasing the effectiveness of interventions designed to enhance motivation since “readiness to change predicts aspects of behavioral and attitudinal change” (Rieger; page 395, paragraph 4, page 388, paragraph 4).

(B) As per claims 4, 12, Strecher teaches an apparatus and medium as analyzed and discussed above.

Strecher fails to explicitly disclose wherein said levels of readiness for change include an unconcerned stage, a precontemplation stage, a contemplation stage and a preparation stage.

However, Rieger teaches wherein said levels of readiness for change include an unconcerned stage (Examiner interprets Rieger’s teaching of “*no thought of changing*” (Rieger; page 389, last paragraph) as reading on “unconcerned stage”), a precontemplation stage, a contemplation stage and a preparation stage (Rieger; page 389, last paragraph to page 391, first paragraph).

The motivations for combining the respective teachings of Strecher and Rieger are as given in the rejection of claims 3, 11 above, and incorporated herein.

7. Claims 5-6, 8, 13-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 as applied to claims 1 and 9 above, and further in view of Douglass et al., U.S. Patent Number 6, 039, 688.

(A) As per claims 5, 13, Strecher teaches an apparatus and medium as analyzed and discussed above.

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wherein: said health promotion schedule is displayed as a screen of a calendar format on a display part of said health promotion practitioner support apparatus or on a terminal which can access said health promotion practitioner support apparatus (Strecher; Figure 1, Figure 5, Figure 5, column 2, lines 53-59, column 6, lines 1-12).

Strecher fails to explicitly disclose

a number of clients is displayed in each day of the calendar format if said clients should receive health promotion on said day, and health promotion details are displayed for each of said clients by selecting said day.

However, the above features are well-known in the art, as evidenced by Douglass.

In particular, Douglass teaches

a number of clients is displayed in each day of the calendar format if said clients should receive health promotion on said day, and health promotion details are displayed for each of said clients by selecting said day (Douglass; Figure 60, column 8, lines 55-64, column 9, line 50 to column 10, line 60, column 18, lines 26-64, column 21, lines 41-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus and medium of Strecher to include these limitations, as taught by Douglass, with the motivations of providing a therapeutic program that could effectively motivate patients to modify their behavior and change their lifestyles to prevent or recover from ailments, and to enable physicians and their staffs to receive frequent feedback regarding patients' compliance with their programs (Douglass; column 1, line 61 to column 2, line 2).

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(B) As per claims 6, 8, 14, 16, Strecher and Douglass teach an apparatus and medium as analyzed and discussed in claims 1, 5, 9, 13 above

wherein data for forming said health promotion schedule includes histories of provided health promotion (Strecher; column 2, lines 42-52), and further comprising:

a part obtaining results of medical examination or tests (Douglass; column 2, lines 35-39); and

a part selecting clients for preventing a specific disease by using said results (Douglass; column 2, lines 35-46).

The motivations for combining the respective teachings of Strecher and Douglass are as given in the rejection of claims 5, 13 above, and incorporated herein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Clark et al., U.S. Patent Application Publication Number 2004/0215491, O'Donnell, U.S. Patent Application Publication Number 2003/0027116, Holland, U.S. Patent Number 6, 607, 483, Summerell et al., U.S. Patent Number 5, 937, 387, and Silver, U.S. Patent Number 6, 269, 339 teach the environment of promoting health.

9. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

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or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

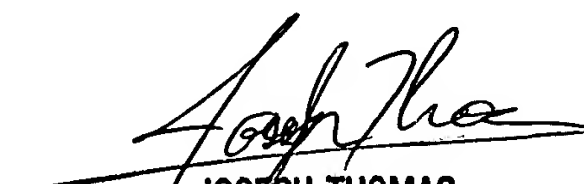
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

September 6, 2005



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600